

REMARKS

Favorable reconsideration of this application in view of the above amendments and following remarks is respectfully requested. Claims 1-5, 7-11, 14-17 and 19 are currently pending. Claims 1, 4, 5, 7, 8, 10 and 17 are currently amended. Claims 6, 12, 13 and 18 have been previously cancelled. No new matter has been added. For purposes of clarity, Applicant addresses each of the Examiner's concerns in the order set forth in the Office Action.

Claims 1-5 and 7-11 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 5,309,539 to Sano *et al.* in combination with U.S. Patent Publication No. 2004/0020681 to Hjortstam *et al.* More specifically, the Examiner has taken the following position:

Hjortstam *et al.* discloses a power cable comprising carbon conducting wire (Figs. 1-4). Hjortstam *et al.* discloses that carbon has high tensile strength, flexibility, and low conduction losses. It would have been obvious to one skilled in the art to use carbon conducting wire as taught by Hjortstam *et al.* for the wires of Sano *et al.* since carbon conducting wires have high tensile strength, flexibility, and low conduction losses.

Regarding the recitation of the "power cord adapted for the transmission of an alternating electrical current," it has been held that the recitation of an element being "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 U.S.P.Q. 138.

Applicant respectfully disagrees with the Examiner's position in this regard and traverses this ground of rejection.

As an initial matter, Applicant respectfully disagrees with the Examiner's position that the claim limitations that recite "adapted for the transmission of an alternating electrical current" does not constitute a limitation in any patentable sense. On the contrary, and consistent with more recent case law pronouncements, tribunals have long held that such language does indeed impart a positive limitation. *See, e.g., In re Venezia*, 189 U.S.P.Q. 149 (CCPA 1976) (court holding that the language "adapted to be fitted" imparted a structural limitation to the sleeve: each sleeve was structured and dimensioned so that it could be fitted over the insulting jacket of

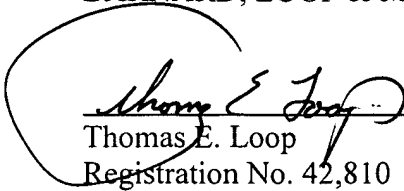
the cable); *Blumenthal v. Barber – Colman Holdings Corp.*, 38 U.S.P.Q.2d 1031 (Fed. Cir. 1995) (unpublished) (court affirming district court's ruling that the claim language "adapted to guide the electrolyte" imparted structural limitations). Nevertheless, and for purposes of expediting allowance, Applicant has elected to amend independent claims 1 and 17 such that they both now recite "[a] power cord configured to transmit an alternating electrical current." In so doing, Applicant respectfully submits that the amended claim language unequivocally imparts positive structural limitations to the claims.

In addition, and also for purposes of expediting allowance, Applicant has also elected to amend independent claims 1 and 17 such that they both now recite the transitional phrase "consisting essentially of" as opposed to the more open transitional phrase "comprising." Because the presently claimed invention now requires first, second, and third carbon conducting wires, and because the references relied upon by the Examiner do not teach or suggest a power cord having only first, second, and third carbon conducting wires, it necessarily follows that the presently claimed invention is patentable over the cited references. Accordingly, Applicant respectfully requests that the Examiner's obviousness rejection be withdrawn.

In view of the above amendments and remarks allowance of claims 1-5, 7-11, 14-17 and 19 is earnestly solicited. A good faith effort has been made to place this application in condition for allowance. If any further matter requires attention prior to allowance, the Examiner is respectfully requested to contact the undersigned attorney at (206) 381-3100 to resolve the same.

Respectfully submitted,

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